



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

*BCJ*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/504,239	02/15/2000	Bruce L. Davis	60114	7614

23735 7590 11/27/2001

DIGIMARC CORPORATION  
19801 SW 72ND AVENUE  
SUITE 100  
TUALATIN, OR 97062

EXAMINER

PATEL, JAYANTI K

ART UNIT	PAPER NUMBER
----------	--------------

2623

DATE MAILED: 11/27/2001

*8*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/504,239

Applicant  
BRUCE L. DAVIS et al.

Examiner  
Jayanti K. Patel

Art Unit  
2623



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Feb 15, 2000

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-23 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-23 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7

20) ☐ Other:

Art Unit: 2623

### **PART III      DETAILED ACTION**

#### ***Drawings***

1. The drawings filed on February 15, 2000 have been objected by draftperson under 37 CFR 1.84. See attached form PTO-948 for draftsperson's comments.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2623

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ramsay et al. (US. 5,502,576) in view of Houser et al. (US. 5,606,609).

Regarding claim 1, Ramsay discloses system for transmission, storage and retrieval of documents in an electronic domain comprising the steps of :

sensing a media object in human-perceptible form ( column 4, lines 29-45), and converting same to electronic form (column 25, lines 35-45); by reference to the object identification data, identifying a set of data stored in a repository at a remote site ( column 26, lines 35-45), the set of data comprising at least one media content file; and sending the set of data from the repository ( column 26, line 46 through column 27, line 20).

The system of Ramsay deals with security related features associated with the document ( column 42, lines 11-30). However, Ramsay is silent about the specific details regarding the step of decoding object identifier.

In the same field of endeavor, however, Houser discloses an electronic document verification system comprising the step of decoding object identification data from the electronic form ( column 20, lines 39-45).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the step of decoding object identification data as taught by Houser in the electronic document processing system of Ramsay because the system of Houser provides Ramsay with an electronic document verification system

Art Unit: 2623

having a security information assembler that, responsive to a user's request assembles security information into a predetermined format. Document processing system of Houser and Ramsay are well known in the document processing art as evidenced by some of the pertinent art cited in this office action.

4. Claims 2-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramsay et al. (US. 5,502,576) in view of Houser et al. (US. 5,606,609) as applied to claim 1 above and further in view of Moskowitz et al. (US. 5,687,236).

As to claim 2, while Ramsay and Houser disclose watermarks with plural bits (see Ramsay, column 8, lines 36-50, and Houser, column 7, lines 45-55) are specifically silent about steganographically encoding watermark data.

In the same field of endeavor, however, Moskowitz discloses a steganographic encoding system comprising the step of steganographically encoding watermark data (column 5, lines 25-40).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the step of steganographically encoding watermark data as taught by Moskowitz in the electronic document processing system of Ramsay because the system of Moskowitz provides Ramsay with a steganographic encoding system which uniquely identifies every copy of multimedia content composed of digital samples whether compressed or uncompressed, including but not limited to still digital images, digital audio and digital video.

Art Unit: 2623

As to claims 3-4, Ramsay discloses a method in which content file represents the same media object as originally sensed but represented with higher fidelity or accuracy ( column 12, lines 1-27) and a variety of media objects including a graphic printed on the page ( column 5, line 57 through column 6, line 25).

As to claims 5-21, Ramsay discloses a conventional electronic document processing system which performs various document processing functions using conventional processors, storage devices, data capture and encoding devices, output devices such as printers and displays ( see figure 2, element 10) at both remote and local sites of interconnected network. The claimed limitations of performing the recited steps at remote or local devices are merely various design preferences and are routinely performed in parallel, synchronously or asynchronously by a variety of document processing devices ( see Ramsay, column 15, line 5 through column 20, line 67, Moskowitz, column 1, line 64 through column 2, line 65).

As to claims 22-23, Ramsay discloses a device comprising an image sensor coupled to a processor which provides decoded output data ( column 25, lines 35-50) including plural-bit watermark data (column 8, lines 36-50) for external use. All other limitations of claims 22-23 are similarly analyzed as claims 1-21 above.

***Other prior art cited***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2623

Mintzer et al. (US. 5,875,249) discloses an invisible image watermarking and verification system (see figure 5, element 103).

Hussey et al. (US. 5,932,862) discloses an optical reader having improved scanning-decoding feature for 1D and 2D bar codes (column 5, lines 15-60).

Bravman et al. (US. 5,866,888) discloses a traveler security and luggage control system (column 4, lines 38-67).

Piva et al. ("DCT-based Watermark Recovering without Resorting to the Uncorrupted Original Image", IEEE, 1997, pages 520-523) discloses the use of digital watermarking in multimedia networking systems (page 520).

Berghel et al. ("Protecting ownership rights through digital watermarking", University of Arkansas, 7-1996, pages 101-103) discloses the use of watermarking as a way to identify the source, creator, owner, distributor, or authorized consumer of a document or user ( page 101).

Art Unit: 2623

***Contact information***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay Patel whose telephone number is (703) 308-7728. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 306-0377. The facsimile phone number for this group is (703 ) 872-9314.

Jkp

Group Art Unit 2623

November 16, 2001

  
JAYANTI K. PATEL  
PRIMARY EXAMINER